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In re Application of :
Young-Taek Sul :
Application No. 10/550,197 : ON PETITION
Filed: September 21, 2005 :
Attorney Docket No.: P57672 :

This is a decision on the petition filed August 9, 2010 under 37 CFR 1.181, requesting that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 3700 (Technology Center Director), dated June 7, 2010, which refused to withdraw the requirement that figure 6 be labeled as "Prior Art".

The petition to overturn the decision of the Technology Center Director in regard to the requirement that figure 6 be labeled Prior Art is **Granted** to the extent indicated.

BACKGROUND

The papers filed relevant to the instant petition are as follows:

A final Office action mailed April 10, 2007 included an objection to the drawing figures indicating that figures 6-8 should be designated as Prior Art.

A petition was filed May 14, 2007 under 37 CFR 1.181 requesting that the drawing objection to claims 6-8 be removed. This petition was dismissed by the Technology Center Director in a decision mailed December 4, 2007.

A renewed petition under 37 CFR 1.181 was filed February 4, 2008. The renewed petition argued only the requirement that figure 6 be labeled Prior Art. This renewed petition was denied by the Technology Center Director in a decision mailed June 7, 2010.

The instant petition was filed August 9, 2010.

OPINION

Petitioner requests relief from the requirement that Figure 6 be labeled as prior art and also requests that the application be returned to the examiner to reprove any assertion that Figure 6 is prior art.

The MPEP provides that: (1) figures showing the prior art are usually unnecessary and should be canceled; and (2) figures showing the prior art may be retained if they are needed to understand applicant's invention and are designated by a legend such as "Prior Art." *See* MPEP 608.02(g). In this application, however, the applicant appears to be contending that Figure 6 is not prior art. Under these circumstances, it is not appropriate to insist that the applicant designate Figure 6 by a legend such as "Prior Art."

It is noted that there is some debate between the applicant and the technology center over the import of the statements in Korean priority application No. 10-2003-0018745 that Figure 6 is a conventional or prior art feature. A determination as to what constitutes prior art is related to patentability. See Aktiebolaget Karlstads Mekaniska Werkstad et al. v. USITC, 705 F.2d 1565, 217 USPQ 865 (Fed Cir 1983); In re Fout, 675 F.2d 297, 213 USPQ 532 (CCPA 1982); and In re Nomiya, 509 F.2d 566, 184 USPQ 607 (CCPA 1975); see also MPEP 2129. Patentability issues, when in question, are matters are for the Board of Appeals and Interferences and are not subject to review by petition. See MPEP 1201. Therefore, this decision should **not** be viewed as reaching the issue of whether Figure 6 in Korean priority application No. 10-2003-0018745 may be treated as a conventional or prior art feature by virtue of the statements contained in that application. This decision simply does **not** require the applicant to amend this application to state that Figure 6 is prior art.

DECISION

The petition is grant to the extent that the requirement that applicant amend this application to state that Figure 6 is prior art is withdrawn.

This application is being forwarded to Technology Center 3700.

Telephone inquires concerning this decision should be directed to Carl Friedman at (571) 272-6842.

Robert W. Bahr
Acting Associate Commissioner
for Patent Examining Policy